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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,897	12/26/2001	Peter J. Kight	23952-0039	9205
72386	7590	12/13/2007		
SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER CAMPEN, KELLY SCAGGS	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/025,897

Applicant(s)

KIGHT ET AL.

Examiner

Kelly Campen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-96 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 79-96 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/10/2007, 6/8/05, 12/26/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

The Restriction Requirement of has been withdrawn in view of the newly filed claims and canceled pending/originally filed claims.

Specification

The abstract of the disclosure is objected to because it uses language which may be implied (see below for further explanation, **emphasis added**). Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Double Patenting

Claims 76-96 of this application conflict with claims 1-30 of Application No. 10/608420. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 76-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 76 is unclear in that it is unclear how the merchant relates to the payer and the payee. It is unclear if this is a third party involved in the payment request. In addition, the

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phrase "based at least in part on at least one of" is vague and indefinite as it is unclear whether the applicant intends to include steps (i) or (ii) and if not, it is unclear how to perform the method as claimed.

Claims 86-96 recite "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record to what statutory class of invention the system claims belong. For the purposes of this examination these claims are considered apparatus.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 76-96 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al. (US 5, 220, 501).

Lawlor et al. disclose a method (and system), comprising: receiving, at a payment service provider, a request to pay a payee on behalf of a payer (see abstract, figures 12, 14a-14d); selecting a form for crediting the payee based at least in part on at least one of (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme; and (ii) comparing a payment amount associated with the received request to a merchant credit

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limit(col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28); and directing a payment to the payee in accordance with the selected form for crediting (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57)[76,86,96].

77 and 87, wherein the form for crediting comprises at least one of (i) a check payable to the payee and written on an account of the payment service provider, (ii) an electronic credit, and (iii) a paper draft payable to the payee and written on an account of the payer (column 33, line 63 - column 34, line 4).

78 and 88, wherein the selected form for crediting is a check written on an account of the payment service provider, and wherein the check is a consolidated check (column 33, line 63 - column 34, line 4).

79 and 89, wherein the request is a first request and the payer is a first payer, and further comprising: receiving a second request to pay the payee on behalf of a second payer; and selecting a check written on an account of the payment service provider as the form for crediting the payee on behalf of the second payer; wherein the consolidated check combines payment of the first request and payment of the second request (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

80 and 90, further comprising: transmitting a remittance list associated with the consolidated check to the payee (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

81 and 91, wherein the electronic credit comprises at least one of (i) an Automated Clearing House (ACH) credit and (ii) a remittance processing system credit (see also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40).

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82 and 92, wherein the selected form for crediting is a paper draft, and the paper draft comprises posting information for the payee (see also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40).

83 and 93, wherein selecting the form for crediting the payee is further based at least in part on an examination of a settlement code associated with the payee (col. 49 lines 20-28).

84 and 94, wherein selecting the form for crediting includes comparing the payment amount associated with the received request to a merchant credit limit; and if the payment amount is less than or equal to the merchant credit limit, then the selected form for debiting is an electronic credit (col. 49 lines 20-28).

85 and 95, wherein selecting the form for crediting includes comparing the payer account number associated with the payee to a merchant account scheme; and
if the payer account number with the payee fails to correspond to the merchant account scheme, then the selected form for debiting is a paper draft (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly S. Campen/
Examiner
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